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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/856,536	05/22/2001	Richard Mcewan	604.30-US1	9172

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EXAMINER

HAYES, JOHN W

ART UNIT PAPER NUMBER

3621

DATE MAILED: 02/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/856,536

Applicant(s)

MCEWAN ET AL.

Examiner

John W Hayes

Art Unit

3621

ML

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 May 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3 August 2001.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Specification

1. The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code (Page 3, line 6). Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 4 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 4-6 recite the limitation "the search engine" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim 8 recites the limitation "the search engine" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claim 6 recites the limitation "the web site" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 14 recites the limitation "the information ordering routine" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 3621

5. Claims 1-6, 8, 10-13 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Monahan et al, U.S. Patent No. 6,523,037 B1.

As per **Claims 1 and 12-13**, Monahan et al disclose an interactive electronic commercial sent to a recipient comprising:

- a commercial message portion that includes a first branding graphic (Figures 12A-13)
- an interface portion that receives a search string designated by the recipient (Col. 5, lines 19-30; Col. 8, lines 30-49); and
- a searching routine that submits the search string to a search engine, and returns results to the recipient from within an e-mail client, without using a browser (Col. 5, lines 27-39; Col. 6, lines 25-31; Col. 7, lines 22-28 and 57-65).

Monahan et al discloses the use of banner ads within an e-mail, however, fails to explicitly disclose a branding graphic portion together with an interface portion that receives a search string. However, Monahan et al since shows the placement of a banner ad within an e-mail message (Figure 12B), examiner submits that it would have been obvious to one of ordinary skill in the art at the time of applicant's invention that banner ads or other branding graphics may be placed within any e-mail message including an e-mail message that allows the entry of a search string such as the interface described above (Col. 5, lines 19-30; Col. 8, lines 30-49). Placing banner ads or other graphics within e-mail messages was well known at the time of applicant's invention and one would have been motivated to include this type of advertising within an e-mail as part of a marketing campaign in order to entice the consumer to purchase certain products.

As per **Claim 2**, Monahan et al further disclose wherein the search string is selected from a list of search strings presented to the recipient in the commercial (Figures 12-13).

Art Unit: 3621

As per **Claim 3**, Monahan et al further disclose wherein the interface portion contains a space into which the recipient types the search string (Col. 5, lines 19-30; Col. 8, lines 30-49).

As per **Claims 4-5**, Monahan et al further disclose wherein the search engine is a commercial searching facility available through a portal other than the commercial or through a web page of the internet (Col. 6, lines 22-31; Col. 12, lines 5-11).

As per **Claim 6**, Monahan et al further disclose wherein the search engine further comprises a graphical hyperlink to the web site (Figure 9A and 12B).

As per **Claim 8**, Monahan et al further disclose a results routine that returns a set of results to the recipient through an interface provided by the commercial based upon submitting the search string to the search engine. (Figure 9A, 12A-12B, 13).

As per **Claims 10-11**, Monahan et al further disclose an audio containing clip included within an email (Col. 9, lines 35-40).

As per **Claim 15**, Monahan et al disclose an interactive electronic commercial sent to a recipient comprising:

- providing the commercial with a commercial message portion that includes a first branding graphic (Figures 12A-13)
- the recipient opening the attachment and displaying an interface portion that receives a search string designated by the recipient (Col. 5, lines 19-30; Col. 8, lines 30-49); and
- an e-mail client submitting the search string to a search engine, and returns results to the recipient from within an e-mail client, without using a browser (Col. 5, lines 27-39; Col. 6, lines 25-31; Col. 7, lines 22-28 and 57-65).

Art Unit: 3621

Monahan et al discloses the use of banner ads within an e-mail, however, fails to explicitly disclose a branding graphic portion together with an interface portion that receives a search string. However, Monahan et al since shows the placement of a banner ad within an e-mail message (Figure 12B), examiner submits that it would have been obvious to one of ordinary skill in the art at the time of applicant's invention that banner ads or other branding graphics may be placed within any e-mail message including an e-mail message that allows the entry of a search string such as the interface described above (Col. 5, lines 19-30; Col. 8, lines 30-49). Placing banner ads or other graphics within e-mail messages was well known at the time of applicant's invention and one would have been motivated to include this type of advertising within an e-mail as part of a marketing campaign in order to entice the consumer to purchase certain products.

6. Claims 7, 9 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Monahan et al, U.S. Patent No. 6,523,037 B1 in view of Fortenberry et al, U.S. Patent No. 6,101,485.

As per **Claims 7, 9 and 14**, Monahan et al disclose a banner ad within an e-mail message, however, does not specifically disclose an ordering routine through which the recipient orders a product. Fortenberry et al discloses a system for electronic solicitations using e-mail and enables a consumer to order products from within the e-mail message (Abstract). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Monahan et al and include the ability to order products from within an e-mail message as taught by Fortenberry. One would have been motivated to include an ordering routine to allow the consumer to purchase the products being promoted.

Conclusion

7. **Examiner's Note:** Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in

Art Unit: 3621

preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Fortenberry et al disclose a method for electronic solicitations using e-mail allowing consumers to order products within an e-mail message and without going to the e-commerce site
- Shaw et al disclose an electronic mail system for displaying advertisements
- Salam et al disclose a system for submitting a search request using e-mail messaging, returning results to the user within an e-mail message and wherein a third party search engine performs the search functions.
- Hirsch discloses a search engine wherein users can submit a search using e-mail and get the results of the search within the e-mail
- Goedken discloses an electronic information exchange system and teach that a user requests information using e-mail and the result set is returned to the user within an e-mail client
- Snyder et al disclose a searching station accessed by terminals and teach wherein a user selects text to be submitted for a search and the results are supplied back to the user.
- Dustin et al disclose a method of delivering targeted, enhanced advertisements across networks.
- Tucciarone et al disclose an electronic messaging system and teach a search facility
- Sheldon et al disclose an e-mail messaging system and also disclose searching facility
- Glasser discloses a method of embedding advertisements in e-mail communications.
- O'Leary, Mick, "ReQUESTer Opens Lexis-Nexis to Web" teaches a software product that allows consumers to e-mail search requests and receive search results in an e-mail.

Art Unit: 3621

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Hayes whose telephone number is (703)306-5447. The examiner can normally be reached Monday through Friday from 5:30 to 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jim Trammell, can be reached on (703) 305-9768.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

Any response to this action should be mailed to:

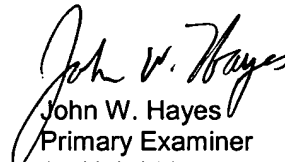
***Commissioner of Patents and Trademarks
Washington D.C. 20231***

or faxed to:

(703) 872-9306 [Official communications; including
After Final communications labeled
"Box AF"]

(703) 746-5531 [Informal/Draft communications, labeled
"PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington,
VA, 7th floor receptionist.


John W. Hayes
Primary Examiner
Art Unit 3621

February 18, 2004